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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,979	08/15/2001	Noah J. Ternullo	12078-141	2164
26486	7590	09/30/2004	EXAMINER	
PERKINS, SMITH & COHEN LLP			GANTT, ALAN T	
ONE BEACON STREET			ART UNIT	PAPER NUMBER
30TH FLOOR			2684	
BOSTON, MA 02108			DATE MAILED: 09/30/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,979	TERNULLO ET AL.	
	Examiner	Art Unit	
	Alan T. Gant	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 August 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 25-28 is/are allowed.
 6) Claim(s) 1-5,7-15,19-24,29 and 31-39 is/are rejected.
 7) Claim(s) 6,16-18,30 and 40 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-5</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Treyz et al.

Regarding claim 1, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz includes a transmitter / receiver for receiving an advertisement containing information from a service provider and for conveying said advertisement to a handheld device, said transmitter comprising means for defining a context for said transmitter; (col. 23, lines 26-35: context meaning location)

means for receiving said advertisement; (col. 1, lines 45-48 and col. 38, lines 38-46)

means for formatting said advertisement into a machine-readable form to produce a transmitted signal compatible with said handheld device; (col. 55, lines 30-40 – device displays advertisement, thus, formatting is inherently performed) and

means for conveying said transmitted signal to said handheld device located within said context, said information displayed to a user of said handheld device if said user has previously expressed an interest in said service. (col. 30, lines 3-21; col. 14, lines 14-40; col. 39, lines 6-62; col. 56, lines 46-51; and col., 54, lines 23-52)

Regarding claim 2, Treyz meets the limitation -The transmitter of claim 1 wherein said conveying means transmits a diffuse infrared signal. (col. 13, lines 10-15 and col. 30, lines 3-21)

Regarding claim 7, Treyz meets the limitation - The transmitter of claim 1 further comprising means for receiving a reply from said handheld device. (col. 20, line 57 to col. 22, line 15)

Regarding claim 9, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz includes a handheld device operating in a context associated with a transmitter / receiver conveying a transmitted signal, said handheld device comprising:

means for receiving said transmitted signal to form a received signal, said received signal containing an advertisement comprising information from a service provider offering a service, (col. 39, lines 6-62)

said received signal further being present if said handheld device is located within said context, said context being communicatively associated with said transmitter; and

(col. 39, lines 6-62)

means for extracting said advertisement if a user of said handheld device has expressed an interest in such a service. (col. 55, lines 31-40)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5, 8, 10-15, 19-24, 29, and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al., in view of Aufricht et al.

Regarding claim 3, the examiner takes Official Notice that it is well known to utilize diffuse infrared signals with wavelengths of 850 nanometers to 1250 nanometers and that it would have been obvious for Treyz to utilize such devices since they are commonly available.

Regarding claims 4, 24, and 32, the applicant's specification admits that the technique of diffuse infrared signals generated by modulating electric light is known in the art. (paragraph 0167)

Regarding claim 5, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services as stated above for claim 1. However, Treyz is silent regarding information transmitter in the form of an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufricht meets the following limitation:

The transmitter of claim 2 wherein said information in the form of an XML element. (paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML beings one of the allowable forms])

Treyz and Aufricht are combinable because they share a common endeavor, namely handheld devices and commerce system that provide advertisements to the user. At the time of the applicant's invention it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

Regarding claims 8, 10, 22, 33, and 38; the examiner takes Official Notice that it is well known to utilize plug-ins associated with interests and that it would have been obvious to modify the Treyz / Aufricht combination to include plug-ins to connect a desired user with the desired interest and filter out those that do not share the interest.

Regarding claim 11, 23, and 31, Treyz meets the limitation - The handheld device of claim 9 wherein said transmitted signal is a diffuse infrared signal. (col. 13, lines 10-15 and col. 30, lines 3-21)

Regarding claim 12, Treyz meets the limitation - The handheld device of claim 9 further comprising means for displaying at least a portion of said information to said user. (col. 10, lines 9-19)

Regarding claim 13, Treyz meets the limitation - The handheld device of claim 12 further comprising means for accepting an input from said user, said input provided in response to said at least a portion of said information. (col. 20, line 75 to col. 22, line 15)

Regarding claim 14, Aufricht meets the limitation -The handheld device of claim 11 wherein said transmitter further includes means for receiving a reply from said handheld device, said reply generated in response to said input. (paragraph 0232) [Also, Treyz – col. 41, lines 11-25)

Regarding claim 15, Aufricht meets the limitation - The handheld device of claim 9 wherein said advertisement is comprised of a first XML element. (paragraph 0033 and Table 1

[placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms)

Regarding claim 19, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz includes a transmitter / receiver for receiving an advertisement containing information from a service provider and for conveying said advertisement to a handheld device, as well as a method for establishing a context of a user having a handheld device, said method comprising the steps of placing a transmitter at a known location, said transmitter having a coverage area associated therewith:

receiving information about a service from a service provider, said information being of interest to said user of said handheld device if located within said coverage area;
(col. 20, line 57 to col. 22, line 15)

and

sending said transmitted signal to said handheld device and displaying said information to a user of said handheld device if said user has established a preference for said information; (col. 55, lines 30-40 and col. 41, lines 11-25)

whereby establishing a context for a user having said handheld device was accomplished. (col. 20, line 57 to col. 22, line 15)

Treyz is silent on passing the information to the handheld device formatted as an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufricht meets the following limitation:

formatting said information into an XML element for conversion into a transmitted signal; (paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML beings one of the allowable forms])

Treyz and Aufricht are combinable because they share a common endeavor, namely handheld devices and commerce system that provide advertisements to the user. At the time of the applicant's invention it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

Regarding claim 20, Treyz meets limitation - The method of claim 19 further comprising: creating a time element at said transmitter; and sending said time element with said XML element; and using said time element to establish a temporal context for said user. (paragraphs 0163 and 0164) [Also Aufricht - paragraph (0165)]

Regarding claim 21, Treyz meets the limitation - The method of claim 19 further comprising the step of utilizing a behavior of said user to establish said preference. (col. 55, lines 30-40)

Regarding claim 29, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services. Treyz describes a method for receiving contextual information contained in an emitted signal received from a transmitter having a coverage area associated therewith, said method comprising the steps of:

establishing a preference for said information; (col. 55, lines 30-40)

Treyz is silent on passing the information to the handheld device formatted as an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufricht meets the following limitation:

receiving said signal containing said information, said information included in a broadcast XML element; (paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms; also Aufricht allows for broadcasting of the information [paragraph 0211]])

processing said broadcast XML element to extract said information; ; (paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms])

displaying at least a portion of said information to said user located within said coverage area if said preference was established prior to receiving said broadcast XML

element whereby said information is received from said transmitter. (paragraph 0180)

Treyz and Aufricht are combinable because they share a common endeavor, namely handheld devices and commerce system that provide advertisements to the user. At the time of the applicant's invention it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

Regarding claim 34, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services and a method of utilizing executable code in a transmitter to establish a context of a user having a handheld device and operating within a coverage area associated with said transmitter, said method comprising the steps of:

receiving information about a service at said transmitter, said information being of interest to a user of said handheld device if said user is located within said coverage area;
(col. 55, lines 30-40)

emitting said signal to said handheld device located within said coverage area, said information displayed to a user of said handheld device. (col. 39, lines 49-62)

Treyz is silent on passing the information to the handheld device formatted as an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for

placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufrecht meets the following limitation:

formatting said information into an XML element for conversion into a signal;
(paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML beings one of the allowable forms])

Regarding claim 35, Treyz meets the limitation - The method of claim 34 wherein said information is only displayed to said user it said user has established a preference prior to receiving said signal. (col. 39, lines 49-62)

Regarding claim 36, Treyz meets the limitation - The method of claim 34 further comprising the steps of:
generating a time element; (paragraph 0165) and
emitting said time element in conjunction with said XML element, said time element for use in establishing a temporal context for said user. (paragraphs 0165 and 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML beings one of the allowable forms])

Regarding claim 37, Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services and consequently a method of

utilizing executable code in a handheld device receiving a signal from a transmitter, said method comprising the steps of:

receiving said signal at a communication interface communicatively associated with said handheld device; (col. 55, lines 30-40)

processing said signal to extract said information contained therein; (col. 39, lines 49-62) and

displaying at least a portion of said information to a user located within said coverage area. (col. 39, lines 6-62)

Treyz is silent on passing the information to the handheld device formatted as an XML element.

Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode. Aufricht allows for placing objects such as interactive advertisements such as Internet or Web content on mobile devices (paragraph 0033). Aufricht meets the following limitation:

establishing a preference for information contained in said signal, said information being formatted as an XML element; (paragraph 0033 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms])

Regarding claim 39, Aufricht meets the limitation - The method of claim 37 wherein said coverage area defines a context for said user receiving said emitted signal. (paragraph 180)

Allowable Subject Matter

Claims 25-28 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 25, a method for establishing a context of a user located within a coverage area associated with a transmitter that includes encapsulating a first XML element in a second XML element and converting the first XML element and the integrity element into a signal was neither found, suggested, nor made evident by the prior art.

Claims 6, 16-18, 30, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 6, 16-18, 30, and 40, information or an advertisement in the form of an XML element encapsulated within an integrity element was neither found, suggested, nor made evident by the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Knutsson et al. discloses an apparatus for a mobile access system delivering location based information and services.

Art Unit: 2684

Liming discloses a system and method providing a software and hardware architecture operating across a local or wide area network that provides an integral spatial and location context.

Any inquiry concerning this communication from the examiner should be addressed to Alan Gantt at telephone number (703) 305-0077. The examiner can normally be reached between 9:30 AM and 6 PM within the Eastern Time Zone. The group FAX number is (703) 872-9306.

Any inquiry of a general nature or relating to this application should be directed to the group receptionist at telephone number (703) 305-4700.

Alan T. Gantt

Alan T. Gantt

September 23, 2004

Nathan

NICK CORSARO
PRIMARY EXAMINER